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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,541	09/22/2003	Olivier J. Poncelet	81354AJJH	9956

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EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/667,541	Applicant(s) PONCELET ET AL.	
	Examiner Daniel S. Metzmaier	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 Sept & 22 Dec. 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-17 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/068,207.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/22/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 8-17 are pending. Claims 1-7 have been cancelled. Claims 8-13 and 17 have been withdrawn as directed to a non-elected invention at this time.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 8-13, drawn to a method of making a composite material, classified in class 424, subclass 421.
 - II. Claims 14-16, drawn to a method of treating an effluent, classified in class 210, subclass 638.
 - III. Claim 17, drawn to a controlled delivery device, classified in class 252, subclass 176.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as process of making and process of using. The inventions are distinct if either or both of the following can be shown: (1) that the process of making as claimed can be used to make other and materially different product or (2) that the process of using as claimed can be performed by another and materially different process. In the instant case the process of making has utilities other than in the method of treating effluents as claimed in the method of using.
3. Inventions of Group I and Group II are related as methods of making an intermediate and a device incorporating said intermediate. In the instant case, the process of making claims do not require incorporation into a controlled release device

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and may be employed in other apparatus and processed that do not require controlled release and/or may be used without such a device in a batch process.

4. Inventions of Group II and Group III are related as methods of using a composite material and a device, which incorporates said composite material for controlled release of the material. The method of using the composite materials do not require the use of a controlled release device in said method.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I or II, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with J. Jeffrey Hawley on September 7, 2005 a provisional election was made with traverse to prosecute the invention of Group II, claims 14-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-13 and 17 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. The possibility of rejoinder of non-elected claims having the same scope of any subject matter, which may be determined to be patentable, will be re-evaluated at a later time.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

9. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/068,207, filed on February 5, 2002. ***Drawings***

10. The drawings were received on September 22, 2003. These drawings are acceptable.

Specification

11. The disclosure is objected to because of the following informalities: The cross-noting section of the specification should be updated to reflect the current status of the parent application.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

13. Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14-16 set forth an "active organic compound". It is unclear for what said "organic compound" is "active".

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Eastman Kodak Co, EP 0 937 393 A1. See example 2, referring to example 1. See also paragraphs [0018] and [0036] et seq regarding effluent processing. Eastman Kodak Co '393 discloses (claims 11-15) methods of treating photographic effluents.

The claimed interconnection by at least two covalent bonds to form an irreversible chemical gel would have been expected to be inherent for the following reasons: (1) the instant application employs silanes including alkylalkoxysilane as the cross-linking agent to form said interconnection. Particular attention is directed to withdrawn, instant original, claim 9. Since Eastman Kodak Co '393 discloses (paragraph [0018]) the use of alkylalkoxysilane treating agents and exemplifies as 3-mercaptopropyltrimethoxysilane a suitable alkylalkoxysilane. It is reasonable to conclude irreversible interconnections at or near physically overlapping fibers.

(2) Eastman Kodak Co '393 further discloses (claim 9) the use of Bis [3-triethoxysilylpropyl] tetrasulfite, which is a divalent triethoxysilane. Said compound

would have been expected to function as a cross-linking agent for the imogolite gel fibers based on the divalent structure. It is further noted, Eastman Kodak Co '393 discloses (claims 5 and 7) the fiber surface have the organic groups including the divalent group $-S-(CH_2)_n-S-$, wherein n can be 0 to 4.

16. Claims 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Poncelet et al, US 6,179,898 B1.

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The rejection over Poncelet et al '898 employs the same reasoning as that presented in the above rejection over the Eastman Kodak Co, EP 0 937 393 A1.

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 14-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,179,898 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims encompass those of '898 and based on the same reasoning set forth above for the anticipation rejections over Eastman Kodak Co, EP 0 937 393 A1 and Poncelet et al, US 6,179,898 B1, the claimed interconnection by at least two covalent bonds to form an irreversible chemical gel would have been expected to be inherent.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Poncelet et al, US 6,440,308 B1, corresponds to Eastman Kodak Co, EP 0 937 393 A1, and could be the basis of a rejection based on Obviousness Double Patenting for the same reasoning set forth in the above rejection. Said rejection has not been made since it would be deemed redundant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM